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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,642	08/19/2003	Steven S. Bordewick	AP.001 US1	6985
7590 05/04/2004			EXAMINER	
Kathleen R. Terry 2417 Como Avenue St. Paul, MN 55108			MITCHELL, TEENA KAY	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/643,642

Applicant(s)

BORDEWICK ET AL.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/13/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: X14, Y15, X vector, and Y vector. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, in claim 10 the receiving means on the other lateral descending arm must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. If applicant is not claiming that a receiving means is on the other lateral descending arm of the biasing means, then claim 10 should be amended to clarify such because as presently presented in claim 10, it appears that a receiving means is located on the other lateral descending arm and such has not been depicted in any figure presented.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because the abstract is more than 150 words in length. Correction is required (note CFR 1.72). See MPEP § 608.01(b).

### ***Claim Objections***

**Claims 1, 3-5, 7-10, 12, and 13 are objected to because of the following informalities:**

Claim 1, line 8, "...about the high forehead..." is indefinite, while it is known where the forehead on an individual would be, the use of the language high forehead makes it unclear as to where the location on the forehead is suppose to be (i.e., the start of the forehead of an individual where the hairline starts, what constitutes the high forehead area?).

Claim 1, line 13, "...to a point forward to the face..." it is unclear if applicant intentions is making reference to a face of a user or if there is some element that has a face, such as the facemask). Clarification should be made.

Claim 3, "...the horizontal length..." lacks antecedent basis.

Claims 4 and 5, "...the length..." lacks antecedent basis.

Claim 7, "...each arm..." is indefinite, it is unclear even though the medial band is bifurcated it is unclear as to what constitutes each arm as no arm has been claimed only the bifurcation, which could have arms but no element has been claimed.

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Claim 7, "...at each side of the medial line..." it is unclear as to what area would constitute a side of the medial line because the medial line is an arbitrary area.

Claim 8, line, 10, "...about the high forehead..." is indefinite, while it is known where the forehead on an individual would be, the use of the language high forehead makes it unclear as to where the location on the forehead is suppose to be (i.e., the start of the forehead of an individual where the hairline starts, what constitutes the high forehead area?).

Claim 8, "...the ends..." lacks antecedent basis.

Claim 8, line 14, "...to a point forward to the face..." it is unclear if applicant intentions is making reference to a face of a user or if there is some element that has a face, such as the facemask). Clarification should be made.

Claim 8, line 16, "...the vertical plane..." lacks antecedent basis.

Claim 8, line 17, "...the distal end..." lacks antecedent basis and also is unclear because what constitutes the distal end of a face mask (is the distal end the outside of the mask, the inside of the mask, the area where the mask seals/touches a user's chin or nose area?).

Claim 9, line 2, "...the circumferential edge..." lacks antecedent basis.

Claim 9, line 8, "...about the upper forehead..." is indefinite because what area on the forehead constitutes "the upper forehead".

Claim 9, line 14, "...the vertical plane..." lacks antecedent basis.

Claim 9, line 15, "...the distal end..." lacks antecedent basis and also is unclear because what constitutes the distal end of a face mask (is the distal end the outside of

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the mask, the inside of the mask, the area where the mask seals/touches a user's chin or nose area?).

Claim 12, line 3, "...the highest point..." lacks antecedent basis.

Claim 13 appears to be an independent claim however the following limitations lack antecedent basis; "...the circumferential and medial bands..."; "...the biasing means..."; "...the head..."; "...the support..."; "...the undercut region of the forehead..."; "...the undercut region of the inion protrusion..."; "...the resultant radially oriented force vectors..."; "...the circumferential band..."; and "...mask support...".

Correction is required.

***Claim Rejections - 35 USC § 101***

**35 U.S.C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

**Claims 1-13 are rejected under 35 U.S.C. 101 because the claims positively recite a part of the human body, they are directed to non-statutory subject matter, which is improper. (e.g., the head, the forehead, the inion protrusion, the high forehead, the occipital bone, the undercut region of the inion protrusion, the apex of the skull).**

Applicant may be guided by the examples provided below with respect to some acceptable claim language.

Claim 1, "adapted to extend from a forehead of a patient to below an inion protrusion of an occipital bone". "adapted to pass over an approximate medial line of a patient's head"

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"adapted to encircle a head of a patient"

"adapted to clamp the support to a head of a patient"

"the circumferential band is adapted to contact a head of a patient"

The examiner has only provided a few examples of suggested appropriate claim language, with respect to claim 1 (as the claim is replete with recitations of parts of the human body, claims 8 and 9 contain the same language and therefore, applicant may be guided by the examples above with respect to suggested appropriate claim language).

Inasmuch as claim 13, lacks antecedent basis and is therefore confusing the examiner cannot provide applicant with specific examples of appropriate language, however "adapted to" or "attached to" language would be proper.

***Claim Rejections - 35 USC § 102***

**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

**Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Ogden et.al. (5,662,101).**

Ogden in a facemask discloses (as best understood by the examiner):

- a mask support (Figs. 1-3)

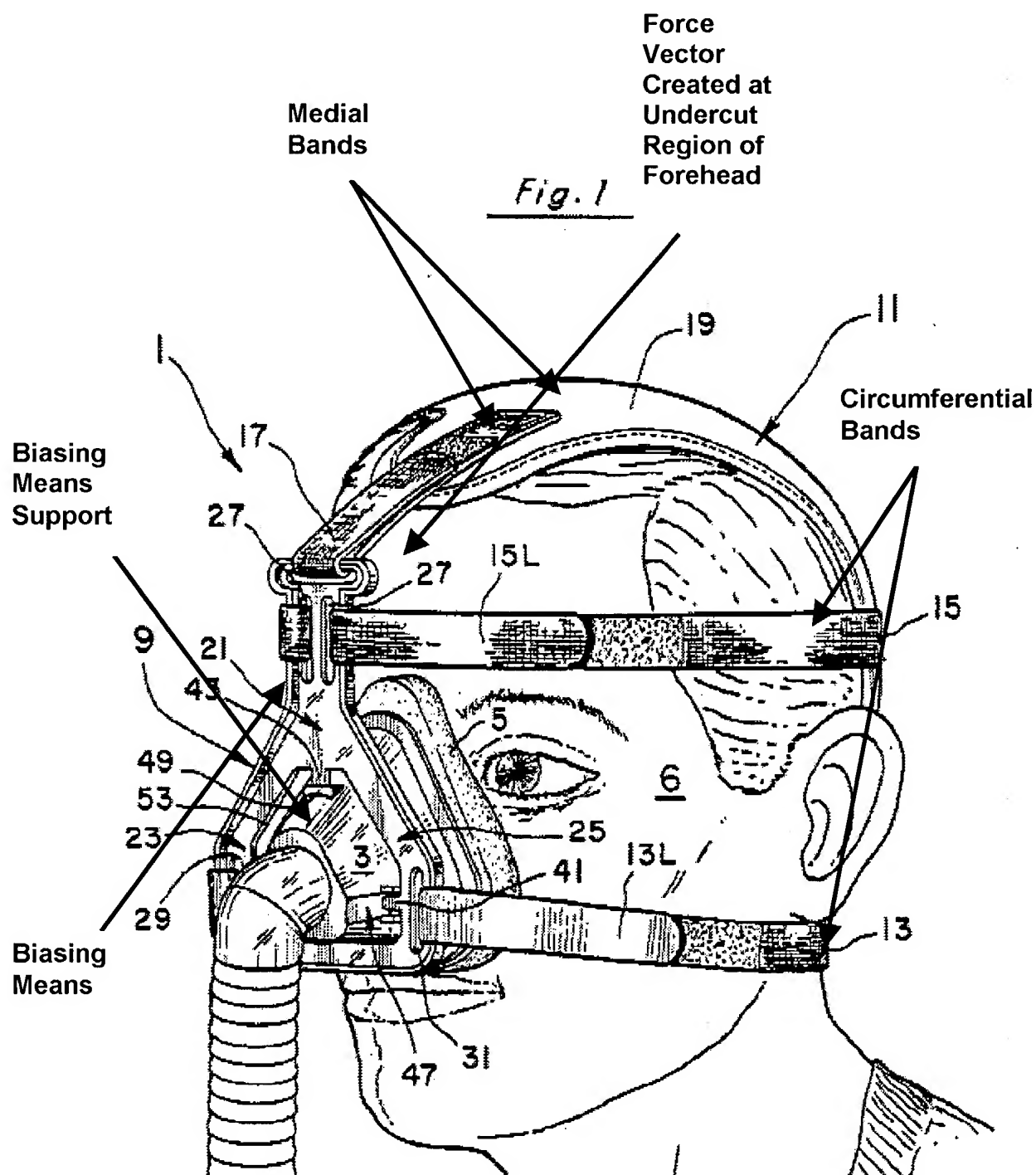
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- wherein the circumferential and medial bands (See Fig. 1 illustrated below) create a stable platform for the biasing means support (See illustration of Fig. 1 below) by encircling the head so as to clamp the support to the head (Figs. 1-3) with force vectors created at the undercut region of the forehead and the undercut region of the inion protrusion and the resultant radially oriented force vectors are established at the region where the circumferential band (see illustration of Fig. 1 below) contacts the head, wherein the mask support is stabilized to resist lateral vector forces. As the medial and circumferential bands are adjusted the vector forces claimed are provided by the mask support taught by Ogden.

The examiner in claim 13 reads vector forces as, pressure, which is applied to the mask of Ogden when the bands are tightened (inasmuch as the vector forces have no structure limitation and have not been depicted in any figure). When the bands of Ogden are tightened a force vector would be created at the undercut of the forehead region by adjustment of band 15 and adjustment of band 13 creates a force vector at the undercut region of the inion protrusion. Once the bands (13, 17, and 15) are adjusted the mask support is stabilized to resist lateral vector forces (note Fig. 1 above).



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### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show facemask and supports: 2004/0025882; 6,530,373; 6,536,435; 6,119,693; 5,623,923; 5,538,000; 5,421,799; 4,593,688; 1,282,527; 1,081,745.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (703) 308-4016. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Teena Mitchell".

Teena Mitchell

Examiner

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May 1, 2004